

Remarks

Claims 1-6, 9-11 and 13-18 are currently pending in the present patent application. Cancel claims 7-8 and 12 without prejudice. Claims 1-4, 9, 11, 13, 15-16 and 18 have been amended. For the convenience of the patent examiner, Applicant will address the issues raised in the order presented in the Office Action dated August 23, 2007.

Claim Objections

1. Claim 8 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 5. In response, claim 8 has been cancelled without prejudice.

Claim Rejections – 35 USC § 103

2.-3. Claims 1-4, 6 and 7 were rejected under 35 USC § 103(a) as being unpatentable over U.S. Pat. Pub. No. 2005/0248437 (Hellebust) in view of U.S. Pat. Pub. No. 2004/0259598 (Wagner). For a claim to be obvious under 35 USC § 103(a), the prior art reference or references when combined must teach or suggest all the claim limitations. MPEP 2142. Claim 7 has been cancelled without prejudice thereby rendering the rejection of claim 7 moot.

With regard to claims 1 and 4 of this patent application from which claims 2-3 (depends directly or indirectly from claim 1) and 6 (depends directly from claim 4) depend, the combination of Hellebust and Wagner do not teach or suggest all the claim limitations of claims 1 and 4.

With regard to Hellebust, the reference discloses a wireless device that can display the number of voice mails, e-mails, pages, and Internet information alerts that have been received by the wireless device during a specified time period. The wireless device analyzes incoming messages to determine classification information based on a retrieved rule set. See, FIGS. 2-3 of Hellebust. Hellebust discloses that the display of the wireless device may also be updated to reflect that a new message has arrived such as by the display of standard or user-defined icons or sounds, the display of summarized message counts by type, or the display of the actual message itself as determined by the message priority and user-defined settings. See paragraph [0011] of Hellebust.

Hellebust does not have: (i) a first indicator including a count to indicate the number of unread electronic messages received; and (ii) altering the first indicator to provide a second

indicator that provides a visually distinguishable annunciation by altering the first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading. Hellebust does not have any comparable structure to the various features described above that are recited in claims 1 or 4. As such, claims 1 and 4 are distinguishable from Hellebust.

With regard to Wagner, the reference discloses a context based mobile device display. The context based mobile device display includes a primary service icon representing a service most likely to be utilized by a user within a predetermined period of time based on user profile information. The carrier provider stores profile information regarding individual subscribers. See paragraph [0034] of Wagner. The carrier provider also stores information regarding each individual subscriber's service usage patterns, such as, what services the individual uses, when they use each service, and how often each service is utilized. See paragraph [0034] of Wagner. Wagner also discloses that an icon (newspaper) can be altered to indicate new information or to show the count of unread messages. See paragraph [0040] and FIGS. 3-4 of Wagner.

While Wagner discloses that an icon can be altered or a count that is capable of being incremented, the reference, like Hellebust, does not have: (i) a first indicator including a count to indicate the number of unread electronic messages received; and (ii) altering the first indicator to provide a second indicator that provides a visually distinguishable annunciation by altering the first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading. The Wagner count is not altered to provide a second indicator that provides a visually distinguishable annunciation that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading. When a count is incremented, the count is not a visually distinguishable annunciation such as flashing the count, bolding the count, changing the size of the count, changing the color of the count, adding indicia to the count and adding an additional count to the count as is disclosed in the patent application. As such, claims 1 and 4 are distinguishable from Wagner.

As can be seen from the review of the Hellebust and Wagner teachings provided

above, Hellebust and Wagner when combined do not have: (i) a first indicator including a count to indicate the number of unread electronic messages received; and (ii) altering the first indicator to provide a second indicator that provides a visually distinguishable annunciation by altering the first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading. As such, claims 1 and 4 are distinguishable from Hellebust and Wagner when combined.

Since independent claims 1 and 4 are believed to be allowable over Hellebust and Wagner for the reasons provided above, dependent claims 2-4 and 6 are believed to be allowable as a matter of law as well. Reconsideration and withdrawal of the rejection to claims 1-4 and 6 under 35 USC § 103(a) is requested.

Also, the U.S. Supreme Court recently stated that, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR International v. Teleflex, Inc., 82 USPQ2d 1385 (2007). The U.S. Pat. Office recently issued examiner guidelines on obviousness findings after the KSR case. 72 Fed. Reg. 57526.

As discussed below, it is respectfully requested that the §103(a) rejection be withdrawn since Hellebust in view of Wagner does not establish a prima facie case of obviousness because one of ordinary skill in the art would not have any motivation to modify the Hellebust reference or to combine the Hellebust and Wagner teachings because the Hellebust reference teaches away from a technical combination with the Wagner reference. A prima facie case of obviousness is rebutted by showing that the art teaches away from the claimed invention. In re Grasselli, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983); MPEP 2145 (X.D.)

As stated above, Hellebust retrieves a rule set (202, 302) and analyzes a message to determine classification information (203, 303). Hellebust flows through several prioritization steps (204, 208, 305) in its logic prior to updating a display (211, 307). See, FIGS. 2-3 of Hellebust. The approach of Wagner is different from that of Hellebust. Wagner employs the use of user profile information that predicts what services the individual uses. See, paragraph [0034] of Wagner. Conversely, Hellebust employs a

prioritization hierarchy. See, FIGS. 2-3 of Hellebust. For this reason, one of ordinary skill in the art would not be motivated to combine Hellebust and Wagner because the suggested combination of the references would require a substantial reconstruction and redesign of the logic shown in Hellebust by redesigning the Hellebust logic to use the Wagner logic. By redesigning the Hellebust logic to use the Wagner logic, the principle of operation of the Hellebust logic has been altered. If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP 2143.01(VI). Reconsideration and withdrawal of the rejection to claims 1-4 and 6 under 35 USC § 103(a) is requested.

4.-5. Claims 9-10 were rejected under 35 USC § 103(a) as being unpatentable over Hellebust in view of Wagner as applied to claim 7 and further in view of Microsoft Outlook 2000. For a claim to be obvious under 35 USC § 103(a), the prior art reference or references when combined must teach or suggest all the claim limitations. MPEP 2142. With regard to claim 4 of this patent application from which claims 9-10 directly or indirectly depend, the combination of Hellebust, Wagner and Microsoft Outlook 2000 do not teach or suggest all the claim limitations of claim 4.

With regard to Hellebust, that reference does not have the features of claim 4 described above. The comments provided above with regard to Hellebust are hereby incorporated into this section of the response as if fully set forth herein.

With regard to Wagner, that reference does not have the features of claim 4 described above. The comments provided above with regard to Wagner are hereby incorporated into this section of the response as if fully set forth herein.

With regard to Microsoft Outlook 2000, the reference discloses a count that can be incremented. Like Hellebust and Wagner, Microsoft Outlook 2000 does not have: (i) a first indicator including a count to indicate the number of unread electronic messages received; and (ii) generating a second indicator that provides a visually distinguishable annunciation by altering the first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading. The Microsoft Outlook 2000 count is not altered to generate a second indicator that provides a visually

distinguishable annunciation that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading. When a count is incremented, the count is not a visually distinguishable annunciation such as flashing the count, bolding the count, changing the size of the count, changing the color of the count, adding indicia to the count and adding an additional count to the count as is disclosed in the patent application. As such, claim 4 is distinguishable from Microsoft Outlook 2000.

As can be seen from the review of the Hellebust, Wagner and Microsoft Outlook 2000 teachings provided above, Hellebust, Wagner and Microsoft Outlook 2000 when combined do not have: (i) a first indicator including a count to indicate the number of unread electronic messages received; and (ii) generating a second indicator that provides a visually distinguishable annunciation by altering the first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading as is claimed in claim 4. As such, claim 4 is distinguishable from Hellebust, Wagner and Microsoft Outlook 2000 when combined.

Since independent claim 4 is believed to be allowable over Hellebust, Wagner and Microsoft Outlook 2000 for the reasons provided above, dependent claims 9-10 are believed to be allowable as a matter of law as well. Reconsideration and withdrawal of the rejection to claims 9-10 under 35 USC § 103(a) is requested.

6. Claims 5, 8 and 11-18 were rejected under 35 USC § 103(a) as being unpatentable over Hellebust in view of Wagner as applied to claim 4 and further in view of U.S. Pat. Pub. No. 2002/0160817 (Salmimaa). For a claim to be obvious under 35 USC § 103(a), the prior art reference or references when combined must teach or suggest all the claim limitations. MPEP 2142. Claims 8 and 12 have been cancelled without prejudice thereby rendering the rejection of claims 8 and 12 moot.

With regard to claims 4 and 11 of this patent application from which claim 5 (depends directly from claim 4) and 13-18 (depends directly or indirectly from claim 11) depend, the combination of Hellebust, Wagner and Salmimaa do not teach or suggest all the claim limitations of claims 4 and 11.

With regard to Hellebust, that reference does not have the features of claim 4 described above. The comments provided above with regard to Hellebust are hereby

incorporated into this section of the response as if fully set forth herein and such comments are equally applicable to claim 11.

With regard to Wagner, that reference does not have the features of claim 4 described above. The comments provided above with regard to Wagner are hereby incorporated into this section of the response as if fully set forth herein and such comments are equally applicable to claim 11.

With regard to Salmimaa, the reference discloses altering icons based on context values such as time of day, geographic area, or user profile preferences. The Salmimaa icon alteration process does not occur since unread electronic messages received were last scanned as is claimed in claims 4 and 11. See paragraph [0013] of Salmimaa and compare that description to page 5, lines 18-30 of the patent application. That section of the specification provides the recitation of, “since the unread messages received were last scanned” used in claims 4 and 11 with certain aspects into the meaning of that recitation. Salmimaa does not have a comparable structure or process to that claim recitation. As such, claims 4 and 11 are distinguishable from Salmimaa.

As can be seen from the review of the Hellebust, Wagner and Salmimaa teachings provided above, Hellebust, Wagner and Salmimaa when combined do not have a second indicator that provides a visually distinguishable annunciation by altering the first indicator that new unread electronic messages have been received since the unread electronic messages received were last scanned without reading. As such, claims 4 and 11 are distinguishable from Hellebust, Wagner and Salmimaa when combined.

Since independent claims 4 and 11 are believed to be allowable over Hellebust, Wagner and Salmimaa for the reasons provided above, dependent claims 5 and 13-18 are believed to be allowable as a matter of law as well. Reconsideration and withdrawal of the rejection to claims 5 and 13-18 under 35 USC § 103(a) is requested.

Also, the technical incompatibility of Hellebust and Wagner negating a prima facie case of obviousness was discussed above. The comments provided above with regard to the technical incompatibility of Hellebust and Wagner is hereby incorporated into this section of the response as if fully set forth herein. Furthermore, Salmimaa is incompatible with the Hellebust reference as well because the Salmimaa reference uses a different logic than is

used by Hellebust. Hellebust employs a prioritization hierarchy. See, FIGS. 2-3 of Hellebust. The approach of Salmimaa is different from that of Hellebust. Salmimaa employs the use of context values, such as time of day, geographic area, or user profile characteristics. See, the Abstract of Salmimaa. As such, one of ordinary skill in the art would not be motivated to combine Hellebust, Wagner and Salmimaa because the suggested combination of the references would require a substantial reconstruction and redesign of the logic shown in Hellebust by redesigning the Hellebust logic to use the Wagner logic and Salmimaa logic. By redesigning the Hellebust logic to use the Wagner logic and the Salmimaa logic, the principle of operation of the Hellebust logic has been altered. If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP 2143.01(VI). Reconsideration and withdrawal of the rejection to claims 5 and 13-18 under 35 USC § 103(a) is requested.

Conclusion

It is respectfully submitted that the present application is in condition for allowance. If the patent examiner would like to suggest changes of a formal nature to place this application in better condition for allowance, a telephone call to Applicant's undersigned attorney would be appreciated.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David P. Maivald". The signature is written in a cursive, flowing style.

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